

REMARKS

This is in response to the Office Action mailed on December 16, 2004, and the references cited therewith.

Claim 22 is amended, no claims are canceled, and no claims are added; as a result, claims 1-31 are now pending in this application. Claim 22 is amended due to informalities, and is not amended to overcome a rejection based on prior art.

§112 Rejection of the Claims

Claim 22 recites the limitations "the encoded name", "the second protocol", "the name", and "the first protocol format." There is insufficient antecedent basis for this limitation in the claim.

Claim 22 is amended to provide proper antecedent basis for all the elements in the claim. Applicant respectfully submits that these amendments to claim 22 should render the objections moot.

§102 Rejection of the Claims

Claims 1-2, 5-7, 9-10, 12-15, 18-19, 22-23, 26-27, and 30-31 were rejected under 35 U.S.C. § 102(e) as being anticipated by Kronz (U.S. Patent No. 6,675,196). Applicant respectfully traverses the rejection because the Office Action fails to establish a *prima facie* case of anticipation with regards to claims 1-2, 5-7, 9-10, 12-15, 18-19, 22-23, 26-27, and 30-31.

"For a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art . . . Although this disclosure requirement presupposes the knowledge of one skilled in the art of the claimed invention, that presumed knowledge does not grant a license to read into the prior art reference teachings that are not there." *Motorola, Inc. v. Interdigital Tech. Corp.*, 43 USPQ2d 1481, 1490 (Fed. Cir. 1997).

Claims 1 and 18 recite, "wherein the name is in a first protocol format; encoding the name into a second protocol format." Claims 7 and 14 recite, "wherein the name is in a first protocol format; an encoder to encode the name into a second protocol format." Claim 10 recites, "a decoder to decode the encoded name from the second protocol format into a name in a first protocol format." Claim 22, as amended, recites, "decoding the encoded name from the

second protocol format into a name in a first protocol format." Claim 26 recites, "wherein the name is in a first protocol format; means for encoding the name into a second protocol format."

In contrast, Kronz at column 1, lines 57-60 states, "The present invention includes a protocol and a method for facilitating communication between various electronic devices and the sharing of features, functionality and information between these devices." (emphasis added) Hence, Kronz fails to teach a name in a first protocol format and a name in a second protocol format as recited above in the quoted claims.

In an example of an attempt to supply missing elements in the claims, the Office Action on pages 3, 7, 9, and 10, with regards to claims 1, 14, 18, and 26 states that Kronz discloses, "wherein the name is in a first protocol format (the server initiates communication utilizing a first protocol, or link protocol, for receiving initial information from a user device, col. 7, lines 4-7)." The Office Action makes a similar statement on page 5 with regards to claim 7, citing column 7, lines 4-15 of Kronz. Applicant disagrees with each of these statements. In column 7, lines 4-7, Kronz states, "As shown in FIG. 3, use of the protocol of the present invention does not begin until communication between a client device and a server device is already established at Step 300 using a link protocol, also referred to as a link layer." (emphasis added) Nowhere in the cited lines does Kronz teach a "name is in a first protocol format" as alleged in the Office Action. Further, with regards to claim 7, nowhere in the cited lines does Kronz teach a "name being in a link protocol" as alleged in the Office Action. Therefore, the Office Action fails to point out where Kronz recites each and every element of the claims 1, 7, 14, 18, and 26 with sufficient clarity to prove its existence in the prior art.

In another example of an attempt to supply the missing elements in the claims, the Office Action, on pages 6 and 10 with regards to claims 10 and 22 respectively, states that Kronz discloses, "utilizing the universal protocol of the system, the client can decode the information into usable data, the data being converted to a native protocol, col 7 line 64 - col 8 line 17." Applicant disagrees. Nowhere in the cited lines of Kronz is there a teaching of "decode the information into usable data," and nowhere is there a teaching of "data being converted to a native protocol," as alleged in the Office Action. Therefore, the Office Action fails to point out where Kronz recites each and every element of the claims 10 and 22 with sufficient clarity to prove its existence in the prior art.

In addition, Kronz teaches away for the "name is in a first protocol format" being a "link protocol," as alleged in the Office Action. Kronz at column 4, lines 1-11 states,

"Link protocols define the basics of how communication is established and maintained between two devices. Data protocols define how meaningful data is exchanged between the two devices using the link protocol as the underlying communication layer. Unless otherwise indicated, the term "protocol," as used below, refers to the data protocol employed by a given connection between two devices to communicate meaningful data, such as the discovery of information about one device and the issuance of commands by one device to the other." (emphasis added)

Since Kronz at column 7, lines 62-64 states, "Among the data fields are one or more device/service identifiers 303-305, each of which represents either a specific device type or a specific service type," Kronz teaches away from data, including device/service identifiers, being in a "link protocol" as alleged in the Office Action. Further, Applicant does not admit that a "device/service identifier" as recited in Kronz is a "name" as recited in the claims of Applicant's invention.

For at least the reasons stated above, Kronz fails to teach each of the elements of claims 1, 7, 10, 14, 18, 22, and 26. Thus, the Office Action has failed to establish a *prima facie* case of anticipation with regards to claims 1, 7, 10, 14, 18, 22, and 26. Therefore, Applicant requests withdrawal of the rejection and reconsideration and allowance of claims 1, 7, 10, 14, 18, 22, and 26.

Claims 5-6 depend from claim 1; claim 9 depends from claim 7; claims 12-13 depend from claim 10, and claims 30-31 depend from claim 26. For reasons analogous to those stated above and elements in the claims, Applicant respectfully submits that the Office Action fails to establish a *prima facie* case of anticipation with respect to claims 5-6, 9, 12-13, and 30-31. Therefore, Applicant requests withdrawal of the rejection and reconsideration and allowance of claims 5-6, 9, 12-13, and 30-31.

§103 Rejection of the Claims

Claims 3-4, 8, 11, 16-17, 20-21, 24-25, and 28-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kronz in view of Ross (Storage over the Internet, iSCSI emerges, Brent Ross, Network World, December 4, 2000). Applicant respectfully traverses the rejection because the Office Action fails to establish a *prima facie* case of obviousness with regards to claims 3-4, 8, 11, 16-17, 20-21, 24-25, and 28-29.

The Office Action must provide specific, objective evidence of record for a finding of a teaching, suggestion, or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *In re Sang Su Lee*, 277 F.3d 1338 (Fed. Cir. 2002). Applicant submits that the statement on page 13 of the Office Action, "It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kronz to encode data in a first protocol of Fibre Channel to a second protocol as taught by Ross to allow for transfer of control codes and data from one Fibre Channel SAN to another Fibre Channel SAN easily and quickly," is not supported by the record, as required by *In re Sang Su Lee*. Ross discloses on page 1, "Tunneling translates Fibre Channel control codes and data into IP packets for transport from one Fibre Channel storage-area network to another remote Fibre Channel SAN." Therefore, Applicant submits that Ross fails to teach or suggest "to encode data in a first protocol of Fibre Channel to a second protocol" as alleged in the Office Action.

Further, Ross, on page 1 states, "The other approach is IP storage, know as iSCSI, which transmits native SCSI over a layer of the IP stack," wherein on page 2 Ross further states, "the encapsulated data is then passed to a TCPI/IP layer that breaks it into packets suitable for transfer over the network." (emphasis added) Applicant submits that the disclosure in Ross fails to teach or suggest "It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kronz to encode data into the iSCSI over TCP/IP protocol as a second protocol for transmission of data as taught by Ross," as alleged on page 13 of the Office Action. (Emphasis added.)

For similar reasons, Applicant submits that the statements on page 14 of the Office Action regarding claims 8 and 11 are also unsupported by the record.

Therefore, the Office Action has failed to provide specific, objective evidence of record for a finding of a teaching, suggestion, or motivation to combine reference teachings, so the Office Action has failed to establish a *prima facie* case of obviousness with regards to claims 3-4, 8, 11, 16-17, 20-21, 24-25, and 28-29.

Even assuming *arguendo* that Kronz and Ross are not improperly combined, the Office Action still fails to establish a *prima facie* case of obviousness with respect to claims 3-4, 8, 11, 16-17, 20-21, 24-25, and 28-29.

Kronz is discussed above. Claims 3-4, 8, 11, 16-17, 20-21, 24-25, and 28-29 are dependent on claims 1, 7, 10, 14, 18, 22, and 26 respectively. As noted above, elements of claims 1, 7, 10, 14, 18, 22, and 26 are not taught or suggested by Kronz. Further, Applicant submits that these elements are not taught or suggested by Ross. Therefore, neither Kronz nor Ross, either alone or in combination, teach or suggest each of the elements of claims 3-4, 8, 11, 16-17, 20-21, 24-25, and 28-29. Thus, the Office Action has failed to establish a *prima facie* case of obviousness with regards to claims 3-4, 8, 11, 16-17, 20-21, 24-25, and 28-29. Therefore, Applicant requests withdrawal of the rejection and reconsideration and allowance of claims 3-4, 8, 11, 16-17, 20-21, 24-25, and 28-29.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6909 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

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March 16, 2005

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 16 day of March, 2005.

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